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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/648,877

08/28/2000

Christopher K. Williams

5169.00001

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23345

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06/19/2006

MCGUIREWOODS, LLP

1750 TYSONS BLVD

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/648,877	Applicant(s) WILLIAMS ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19, 21-40, 42-56 and 58-79 is/are pending in the application.
- 4a) Of the above claim(s) 2-19, 25-40, 42-56 and 62-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24, 58-61 and 68-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/4/2006 have been fully considered but they are not persuasive.
2. The Examiner's response to the applicant's arguments is incorporated in the rejection found below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 and 68-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill et al. (US Patent No. 6,473,740).

As per claims 21 and 68, Cockrill et al. disclose a system and method of conducting a transaction between a consumer, a merchant computer, and a billing computer connected together over a computer network, wherein the consumer purchases a product or service from the merchant computer by charging the value of the product or service to a consumer billing account. Cockrill et al further teach aggregating a multiplicity of transactions that involve the consumer" and "charging the aggregated multiplicity of transactions to a consumer billing account" upon

the occurrence of an event. Applicant is directed to column 4, line 62 to column 5, line 16 and column 7, line 54 to column 8, line 27 and column 9, lines 1-14 of Cockrill et al.

Cockrill et al further teach charging a processing fee corresponding to the multiplicity of transactions as “the network credits the accounts of the merchants of the constituent transactions in accordance with the business arrangement between the merchants and the operator of the network”. See column 14, lines 10-24. Cockrill et al do not explicitly teach incurring the processing fee on the customer. Such would have been obvious to one of ordinary skill in the art to do because the system of Cockrill et al provides on time registration of the user and reduces purchasing time on the part of the user. Thus, charging a processing fee as well to the consumer would have been obvious to one of ordinary skill in the art to do because of the facilitating services provided to the consumer and also for the maintenance of the overall system of Cockrill et al.

As per the limitation of an unscheduled or scheduled event applicant is directed to column 5, lines 1-6 as (“when the amounts of these records exceed a threshold value, preferably determined based upon the amount at which the transaction costs for the form of payment provided by the customer become reasonable, the network generates a payment request requesting payment of the total amount”). See also column 8, lines 12-22 of Cockrill et al.

Applicant’s representative argues that Cockrill et al do not teach or suggest “incurring from a consumer billing authority a processing fee corresponding to the multiplicity of transactions” and states that the passage relies by the Examiner refers to a credit which is the opposite of a fee.

In response, the Examiner disagrees with the applicant's assertion. On column 14, lines 2-25, it is stated that in a transaction record of a \$1.00 US value between a merchant and a customer, \$0.90 would be credited to the merchant. Cockrill et al. state that a business arrangement is made between the merchants and the operator of the network. From this statement, it would have been obvious to one of ordinary skill in the art at the time the invention was made to note that in the agreement, the merchant would receive 90% of the transaction and the network operator would have received 10% of the transaction that is a processing fee. Moreover, charging a processing fee to the merchant and/or to the customer by the network owner or network operator would have been obvious to do in the system of Cockrill et al because the network owner or operator facilitates financial transactions between the merchant and the customer. A processing fee would have been to maintain and operate the overall system.

As per claim 22, Cockrill et al teach directly charging those of the multiplicity of transactions that meet predetermined criteria to the consumer billing account such as the amounts of records of transactions exceeding a threshold value. See column 8, lines 12-24. Charging any other transactions is not being prevented or denied in the system of Cockrill et al. Since the purpose of Cockrill et al is to sell and make a sufficiently reasonable profit, then selling and directly charging multiplicity of transactions that meet or do not predetermined criteria such as expensive goods/services would have been made because of business and profit opportunities. Such would have been obvious to o by the ordinary skill in the art when modifying Cockrill et al for business and profit purposes.

As per the limitation of “obtaining from the consumer billing authority a pre-authorization that permits charging a predetermined amount to the consumer billing account” of claims 23 and 24, applicant is directed to column 5, lines 1-6 as (“when the amounts of these records exceed a threshold value, preferably determined based upon the amount at which the transaction costs for the form of payment provided by the customer become reasonable, the network generates a payment request requesting payment of the total amount”). See also column 8, lines 12-22 of Cockrill et al.

Applicant has amended claim 16 to recite that the charges of the multiplicity of transactions occur at the time of transaction that meet predetermined criteria to the customer billing account and that Cockrill discloses periodically reviewing records to determine if the amounts should be charged.

In response, the manner timing of charging the customer is not an unobvious feature in Cockrill et al because in finalizing a financial transaction involving the purchasing of a good or service, the customer involved in the particular transaction is usually billed for the supplied goods or services. Thus, charging the customer at the time of transaction or at a predetermined time would have been left to the entities involved in the transaction, and that any of the alternative would have been obvious to do by one of ordinary skill in the art when viewing Cockrill et al.

As per claims 23 and 24 applicant’s representative argues that Cockrill et al do not teach or suggest a function of obtaining from the consumer billing authority a pre-authorization that permits charging a predetermined amount to the consumer billing account”.

In response, Cockrill et al state the network generates a payment request for the determined sum against the credit card, or other form of payment of the customer. In a preferred embodiment, the generated payment request has two parts: an authorization request, and a settlement request. The authorization request requests the authority to charge the amount, while the settlement request requests actual payment of the amount". See column 13, lines 57. This request is made if the amount is at a particular amount such as exceeding a transaction amount.

Regarding claim 69, as per the claimed limitations of "a total of the aggregated multiplicity of transactions exceeding a monetary value", Cockrill et al teaches continuing billing the consumer and performing a payment request "if the sum is greater than a billing threshold". See column 13, lines 34-47 and column 8, lines 9-18 of Cockrill et al.

Regarding claim 70, as per the claimed limitations of "a total number of the aggregated multiplicity of transactions exceeding a predetermined number". The objective of Cockrill et al is to prevent transmitting a single charge related to a single transaction of a low cost item (goods or services) performed by a consumer to a billing authority. Cockrill et al accumulate a number of transactions related to a particular consumer and subsequently request a payment to a billing authority. See column 4, line 66 to column 5, line 5 and column 9, lines 9-14. Setting a limit as to a total number of the aggregated multiplicity of transactions exceeding a predetermined number is not explicitly stated. However, such would have been obvious to do by one of ordinary skill in the art in the system of Cockrill et al so that an automatic payment request may be made once a number of transactions is made. The motivation would have been to lower

merchants' transaction processing costs, thereby enabling merchants to offer for sale modestly-priced goods.

Regarding claim 71, Cockrill et al do not explicitly teach an event comprising a total number of the aggregated multiplicity of transactions exceeding a predetermined time period. Cockrill et al teach updating data to reflect the present time as the time of a last purchase. See column 12, lines 14-21. Cockrill et al also teach aggregating multiplicity of transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an event comprising a total time period elapsed since a transaction exceeding a predetermined time period in the system of Cockrill et al in order have a further control on how to aggregate the multiplicity of transactions. The motivation would have been to have a further control on how to aggregate the multiplicity of transactions so as to make a single payment request thereby providing other means of lowering merchants' transaction processing costs, thereby enabling merchants to offer for sale modestly-priced goods.

Regarding claim 72, steps of determining if a new transaction meets or exceeds a predetermined monetary value and aggregating the new transaction in (a) only when the new transaction does not exceed the predetermined monetary value is not explicitly stated in Cockrill et al. Cockrill et al teach collecting transaction records and "[W]hen the amounts of these records exceed a threshold value, preferably determined based upon the amount at which the transaction costs for the form of payment provided by the customer become reasonable, the network generates a payment request requesting payment of the total amount". See column 8,

lines 11-18. Thus, Cockrill et al concern as to whether one or more transactions exceed a predetermined monetary value. Cockrill et al further aggregate one or more transactions. Determining if a new transaction meets or exceeds a predetermined monetary value and aggregating the new transaction in (a) only when the new transaction does not exceed the predetermined value would have been obvious to one of ordinary skill in the art to do in modifying the system of Cockrill et al. The motivation would have been to have a further control on how to aggregate the multiplicity of transactions so as to make a single payment request thereby providing other means of lowering merchants' transaction processing costs, thereby enabling merchants to offer for sale modestly-priced goods.

As per claim 73, Cockrill et al state the network generates a payment request for the determined sum against the credit card, or other form of payment of the customer. In a preferred embodiment, the generated payment request has two parts: an authorization request, and a settlement request. The authorization request requests the authority to charge the amount, while the settlement request requests actual payment of the amount". See column 13, lines 57. This request is made if the amount is at a particular amount such as exceeding a transaction amount. As per the limitation of "re-obtaining pre-authorization based on a predetermined period of time expiring from the previous pre-authorization", the Examiner asserts that if the time limit of a pre-authorization is expired, and the involved entities such as the customer and the billing authority desire to conduct transaction, then re-obtaining a pre-authorization based on a predetermined period of time expiring from a previous pre-authorization would have been obvious to one of

ordinary skill in the art to note and to do so as to continue conducting business between the involved entities in the case a payment is required to be administered.

As per claim 74, specifically regarding the limitation of determining at the time of each transaction whether the transaction amount exceeds a pass-through amount and if so, charging the transaction amount directly to the customer billing account,

Cockrill et al state the network generates a payment request for the determined sum against the credit card, or other form of payment of the customer. In a preferred embodiment, the generated payment request has two parts: an authorization request, and a settlement request. The authorization request requests the authority to charge the amount, while the settlement request requests actual payment of the amount". See column 13, lines 57. This request is made if the amount is at a particular amount such as exceeding a transaction amount.

The manner of charging the customer as claimed is not unobvious in Cockrill et al because in finalizing a financial transaction involving the purchasing of a good or service, the customer involved in the particular transaction is usually billed for the supplied goods or services. Thus, charging the customer at the time of transaction or at a predetermined time would have been left to the entities involved in the transaction, and that any of the alternative would have been obvious to do by one of ordinary skill in the art when viewing "Cockrill et al.

As per claim 75, Cockrill et al discloses analyzing the cost for each particular transaction for a given customer. Determining whether or not to perform steps a) and b) based on the type of each transaction would have been obvious to do in the system of Cockrill et al depending on the cost and/or processing fees of each transaction.

4. Claims 58-61 and 76-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill et al. (US Patent No. 6,473,740) in view of the article entitled "Ambalink Launches secure Online shopping in the UK".

As per claim 58, Cockrill et al disclose a system and method of conducting a multiplicity of transactions between a consumer and at least one merchant computer at a billing computer.

See the abstract. Cockrill et al teach:

The consumer, the at least one merchant and the billing computer are connected over a network (see figure 1);

Each transaction is for a product or service that the consumer purchases using the at least one merchant computer (see column 9, lines 1-10 and column 3, lines 57-62);

The method comprises the steps of conducting for each of the multiplicity of transactions of initiating the transaction for the product or service. (column 9, lines 1-10 and column 3, lines 57-62).

Cockrill et al do not explicitly teach receiving an authorization code from the consumer indicating authorization to conduct the transaction, determining whether to approve the transaction by considering the authorization code and transmitting approval to conduct the transaction to the merchant computer if the transaction is approved.

The Ambalink system discloses a system and method of conducting a transaction between a consumer, a merchant computer, and a billing computer connected together over a computer network, wherein the consumer purchases a product or service from the merchant computer by charging the value of the product or service to a consumer billing account. In the Ambalink system, customers' accounts are charged for transactions performed by the customers,

and consumers indicate authorization to conduct a transaction based on an authorization code and fulfilling the transaction if the transaction is approved by the merchant. See the entire article. In the Ambalink system the billing computer does not transmit information identifying the consumer billing account to the merchant computer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of the Ambalink into the system of Cockrill et al in order to provide a secure system so as to provide unauthorized transactions from occurring.

Cockrill et al. further disclose all the claimed features, particularly, a system and method of conducting a transaction between a consumer, a merchant computer, and a billing computer connected together over a computer network, wherein the consumer purchases a product or service from the merchant computer by charging the value of the product or service to a consumer billing account. Cockrill et al further teach “aggregating a multiplicity of transactions that involve the consumer” and “charging the aggregated multiplicity of transactions to a consumer billing account” upon the occurrence of a specified event”. Applicant is directed to column 4, line 62 to column 5, line 16 and column 7, line 54 to column 8, line 27 and column 9, lines 1-14 of Cockrill et al.

Cockrill et al also teach charging a processing fee corresponding to the multiplicity of transactions as “the network credits the accounts of the merchants of the constituent transactions in accordance with the business arrangement between the merchants and the operator of the network”. See column 14, lines 10-24. Incurring the processing fee on the customer is not explicitly taught by Cockrill et al. Such would have been obvious to one of ordinary skill in the art to do because the combined system of Cockrill et al and the Ambalink provides on time

registration of the user and reduces purchasing time on the part of the user. Thus, charging a processing fee as well to the consumer would have been obvious to one of ordinary skill in the art to do in the combination above because of the facilitating services provided to the consumer and also for the maintenance of the overall combined system.

Applicant has amended the independent claim 58 to recite “determining at the time of each transaction whether the transaction amount exceeds a pass-through amount and if so, charging the transaction amount directly to the customer billing account, and if each transaction amount does not exceed the pass-through amount, aggregating each transaction as part of the multiplicity of transactions.

As per these limitations, Cockrill et al teach aggregating a multiplicity of transactions when the transactions amount(s) exceed a predetermined amount thus not for each individual transaction. See column 5, lines 1-10 of Cockrill et al. However, it should be noted if each of a plurality of individual transactions reaches the threshold amount then the customer’s account would be charged at the time of each of these transactions.

Furthermore, Cockrill et al state the network generates a payment request for the determined sum against the credit card, or other form of payment of the customer. In a preferred embodiment, the generated payment request has tow parts: an authorization request, and a settlement request. The authorization request requests the authority to charge the amount, while the settlement request requests actual payment of the amount”. See column 13, lines 57. This request is made if the amount is at a particular amount such as exceeding a transaction amount.

Furthermore, the manner of charging the customer as claimed is not unobvious when viewing Cockrill et al because in finalizing a financial transaction involving the purchasing of a good or service, the customer involved in the particular transaction is usually billed for the supplied goods or services. Thus, charging the customer at the time of transaction or at a predetermined time would have been left to the entities involved in the transaction, and that any of the alternative would have been obvious to do by one of ordinary skill in the art when viewing “Cockrill et al.

As per claim 59, claim 59 contains limitations recited in independent claim 58 and these limitations are rejected under a similar rationale. Claim 59 further recites a step of charging those of the multiplicity of transactions that meet predetermined criteria to the consumer billing account”. As per this limitation, Cockrill et al teach directly charging those of the multiplicity of transactions that meet predetermined criteria to the consumer billing account such as the amounts of records of transactions exceeding a threshold value. See column 8, lines 12-24 of Cockrill et al..

As per claim 60, claim 60 contains limitations recited in independent claim 58 and these limitations are rejected under a similar rationale. Claim 60 further recites a step of “obtaining from the consumer billing authority a pre-authorization that permits charging a predetermined amount to the consumer billing account”. As per this limitation, applicant is directed to column 5, lines 1-6 as (“when the amounts of these records exceed a threshold value, preferably determined based upon the amount at which the transaction costs for the form of payment

provided by the customer become reasonable, the network generates a payment request requesting payment of the total amount”). See also column 8, lines 12-22 of Cockrill et al.

As per claims 61 and 78, claims 61 and 78 contain limitations recited in independent claim 60, and these limitations are rejected under a similar rationale. Claim 61 further recites the step of “charging those of the multiplicity of transactions that meet predetermined criteria to the consumer billing authority”. Cockrill et al teach charging those of the multiplicity of transactions that meet predetermined criteria to the consumer billing account such as the amounts of records of transactions exceeding a threshold value. See column 8, lines 12-24 of Cockrill et al.

As per claims 76 and 79, Cockrill et al state the network generates a payment request for the determined sum against the credit card, or other form of payment of the customer. In a preferred embodiment, the generated payment request has two parts: an authorization request, and a settlement request. The authorization request requests the authority to charge the amount, while the settlement request requests actual payment of the amount”. See column 13, lines 57. This request is made if the amount is at a particular amount such as exceeding a transaction amount. As per the limitation of “re-obtaining pre-authorization based on a predetermined period of time expiring from the previous pre-authorization”, the Examiner asserts that if the time limit of a pre-authorization is expired, and the involved entities such as the customer and the billing authority desire to conduct transaction, then re-obtaining a pre-authorization based on a predetermined period of time expiring from a previous pre-authorization would have been

obvious to one of ordinary skill in the art to note and to do so as to continue conducting business between the involved entities in the case a payment is required to be administered.

As per claims 77, in the Ambalink system, the consumer must sign a payment request using his/her secret code or authorization code. Ambalink teaches redirecting the consumer to a web site of the billing computer for receiving the authorization code. See page 2 of the article.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-

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6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frantzy Poinvil
Primary Examiner
AU 3628

FP

June 7, 2006